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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,644	06/15/2005	Uwe Hannsmann	DE920020028US1	8626
47069 7590 10/16/2009 KONRAD RAYNES & VICTOR, LLP ATTN: IBM54 315 SOUTH BEVERLY DRIVE, SUITE 210 BEVERLY HILLS, CA 90212				
EXAMINER CHEMPAKASERIL, ANN J				
ART UNIT 2166		PAPER NUMBER		
NOTIFICATION DATE 10/16/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

krvuspto@ipmatters.com

Office Action Summary

Application No.

10/539,644

Applicant(s)

HANNSMANN ET AL.

Examiner

ANN J. CHEMPAKASERIL

Art Unit

2166

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 16, 17, 39, 40 and 45-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 16-17, 39-40, 45-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-2, 16-17, 39-40, and 45-62 are pending.

Claim Rejections - 35 USC § 112

2. Claims 40, 52, and 60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 40, 52, and 60 recites determining the amount of usage of the content data at the client after a license status is expired at the client. The specification does not enable usage of content data after a license status is expired. The specification does not detail how the content can be used when the license is expired. In paragraph [0041] of the specification, it states, "if the license status is insufficient for rendering, rendering is disabled". The specification does not detail how a disabled license can still be used after expiration provided the usage is monitored. The specification does not indicate the type of license used where it is possible for the content to be used after expiration of the license. In paragraph [0049], applicant discloses, the rendering application program updates the license information stored in the local license database by calling the common license client API. For example if the license encompasses the fixed number of playbacks of the content data the remaining number of playbacks is decremented accordingly by the common license client. When the license has been used up renewal

of the license is requested in step 424 from the client. Applicant does not show the continuous usage of content data after expiration, provided the usage is tracked. In fact, applicant shows that renewal of license is needed, to continue content usage. The specification does not teach one of ordinary skilled in the art how to make and use the full scope of the claimed invention without undue experimentation.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 39-40, 47, 51-52, 55, 59-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 47, and 55 states "synchronizing with local license related data on the client indicating an updated license status comprising the available content usage included in the file sent to the client reduced, at the client, by an amount of actual client usage of the content data at the client following the sending of the file to the client and before the synchronizing." It is unclear how the client receives an updated license following sending of the file and before synchronizing. Examiner directs applicant to page 10 of specification to amend claims to reflect the invention and overcome the 112 rejection. Specifically, examiner suggests that applicant clarify the features of actual client usage by including that "the amount of usage of the content data after expiration of the original license is tracked and stored by the common license client 311 in local

license database 208. When the client computer 108 is re-connected to the network license a synchronization of entries which have been made in local license database 308 is performed by means of synchronization module 307 and renewal module is started to renew the license and provide payment for the amount of usage of the content data after expiration of the original license." Clarification is required.

Claim 39, 51, and 59 recites "actual usage of the content data at the client after the license status is expired at the client when there is no more available content usage" It is unclear how there is any usage when there is no more available content usage. It is unclear what content is being used when there is a lack of available content. Examiner suggests that applicant amends the claimed to include features recited on page 9 of applicants' arguments, "user continues to use the content data even after the original license has been exhausted provided the amount of usage after expiration of the original license is tracked and stored in the license database for later payment."

Claim 40, 52, and 60 recites during synchronization, determining the amount of usage of the content data at the client after the license status is expired at client, receiving payment for the amount of usage of the content data after the license status is expired, wherein the synchronizing with the local license related data comprises renewing the local license related data to allow continued use of the content data in response to receiving the payment for the amount of usage. It is unclear to the examiner, how the amount of usage can be tracked when the license is expired. It is unclear to the examiner, what type of license was used to render content when content is expired.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 16-17, 39-40, and 45-62 are rejected under 35 U.S.C. 103(a) as being unpatentable by US Patent Application 2003/0088516 issued to Remer et al. further in view of US Patent 7203966 issued to Aburri et al. (hereinafter Aburri)

As per claims 1, 47, and 55, Remer discloses a method for providing of content data to a client (move logic and data over networks to the end user or point- of service (POS) computer [0033]), comprising:

receiving of a selection of content data from the client (selection of licenses are requested by POS that access data, [0033]);

generating a file comprising license information and a locator for the content data, wherein the license information indicates a license status enabling the client to access the content data wherein the available content usage indicates an amount of content available to the client according to a scope of a license (The service agent first verifies that the digital signature of the retrieved POS license is valid (310). If so, the service agent compares the Node ID field of the current POS license with the Node ID of the existing license in the discovery database (330). If the Node IDs are different,

then this must be a new POS license that has not yet been collected to the discovery database. The service agent collects a copy of the new POS license into the Servicing component's discovery database (340). [0077];

sending of the file to the client (sending the file with license and id to POS [0079]);

Remer does not appear to explicitly disclose, synchronizing with local license related data on the client indicating an updated license status comprising the available content usage included in the file sent to the client reduced, at the client, by an amount of actual client usage of the content data at the client following the sending of the file to the client and before the synchronizing.

However Aburri discloses the claimed the license status indicates available content usage (The license includes: a decryption key (ED) that decrypts the encrypted digital content; a description of the rights (play, copy, etc.) conferred by the license and related conditions (begin date, expiration date, number of plays, etc. [Col 3, lines 5-15]);

synchronizing with local license related data on the client indicating an updated license status comprising the available content usage included in the file sent to the client reduced, at the client, by an amount of actual client usage of the content data at the client following the sending of the file to the client and before the synchronizing. (corresponding to licenses 16 presently or formerly in the license store 38. Such state information is created by the DRM system 32 and stored in the state store 40 as necessary. For example, if a particular license 16 only allows a predetermined number of renderings of a piece of corresponding digital content 12, the state store 40 maintains

state information on how many renderings have in fact taken place in connection with such license 16 [Col 17, lines 55-69] That is, each copy/replacement license utilizes a relatively short-term expiration date instead of the original expiration date so that long-term continued use of a copy/replacement license requires periodic contact with the license synchronization server in order to update the expiration date (hereinafter "expiry") at step 2740. [Col 58, lines 35-50])

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms. [Col 3, lines 35-50])

As per claim 2, 48, and 56, Remer discloses in response to receiving the selection of the content data from the client, requesting of license conditions information from a license server (license conditions can be retrieved from servicing agent for the POS [0031]) ;

sending of information indicative of one or more license offers to the client (The current POS license, whether it be an install, trial, or previously purchased license, is collected by the external license servicing agent to a discovery database that resides on the service management console [0035]);

and receiving an acceptance from the client (an electronic commerce site that will issue purchased licenses for the software services installed on the POS computers (240). By purchasing, the client accepts the license offers.)

As per claim 16, 49, and 57, Remer discloses the generated file comprises an XML file having a defined DTD format (The exchange of licenses may be accomplished in a number of ways. In one example implementation of the method, the exchange is accomplished by formatting an exchange license file that is in well-formed, non-validated XML described by the following DTD [0087]).

As per claim 17, 50, and 58, Aburri discloses receiving a request to renew the license from the client and make payment for the renewal in response to the client determining that the updated license status indicates that the license has expired (A purpose of such contact is to synchronize the server's license information with the user's device's license information. For example, when user next connects to synchronization server 1402 from a computing device, e.g. 1302a, any new licenses now contained in the license store 1524 on license synchronization server 1402 will be downloaded to device 1302a and any licenses contained in license store 1510a on device 1302a not in license synchronization server 1402 license store 1524 will be uploaded to server 1402. License synchronization server 1402 may send device 1302a copy/replacement license for any licenses that device 1302a has newly uploaded to the license synchronization server. Copy/replacement licenses are stored in license store 1510a on computing device 1302a [Col 62, lines 40-55])

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It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms... [Col 3, lines 35-50])

As per claim 39, 51, and 59, Aburri discloses the usage of the content data at the client after the license status is expired at client when there is no more available content usage. (copy/replacement license may also expire, however, if a user does not connect and synchronize with the license synchronization server from a device before the expiry date of the copy/replacement license. [Col 63-Col 64])

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms. [Col 3, lines 35-50])

As per claim 40, 52, and 60, Aburri discloses during synchronization, determining the amount of usage of the content data at the client after the license status is expired at client (copy/replacement license may also expire, however, if a user does not connect and synchronize with the license synchronization server from a device before the expiry date of the copy/replacement license. [Col 63-Col 64]);

receiving payment for the amount of usage of the content data after the license status is expired, wherein the synchronizing with the local license related data comprises renewing the local license related data to allowed continued use of the content data in response to receiving the payment for the amount of usage

(copy/replacement license may also expire, however, if a user does not connect and synchronize with the license synchronization server from a device before the expiry date of the copy/replacement license. [Col 63-Col 64])

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms. [Col 3, lines 35-50])

licenses with new licenses using the discovery database. [0023])

As per claim 45, 53, and 61, Aburri discloses the available content usage indicates a fixed number of allowed play, wherein the license status is expired after the content is rendered the fixed number of allowed playbacks (The license includes: a decryption key (ED) that decrypts the encrypted digital content; a description of the rights (play, copy, etc.) conferred by the license and related conditions (begin date, expiration date, number of plays, etc. [Col 3, lines 5-15])

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms. [Col 3, lines 35-50])

As per claim 46, 54, and 62, Aburri discloses the available content usage indicates duration of the content playback (A copy/replacement license may expire

because the end of the time period for which an original license pertains has been reached [Col 63, lines 35-40]

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms. [Col 3, lines 35-50])

Contact Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann J. Chempakaseril whose telephone number is 571-272-9767. The examiner can normally be reached on Monday through Thursday, 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ann J Chempakaseril/
Examiner, Art Unit 2166
October 9, 2009

/Hosain T Alam/

Supervisory Patent Examiner, Art Unit 2166